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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,668	02/08/2002	Heinrich Englert	P6608.0US	4591
30008	7590	11/16/2005	EXAMINER	
GUDRUN E. HUCKETT DRAUDT LONSSTR. 53 WUPPERTAL, 42289 GERMANY			GOODMAN, CHARLES	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/073,668

Applicant(s)

ENGLERT ET AL.

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4-7 and 16-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4-7 and 16-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. The Amendment filed on 8/24/2005 has been entered.
2. The drawings were received on 8/24/05. These drawings are not accepted because they introduce new matter. Contrary to Applicant's assertions, the depiction shown in the resubmitted Fig. 7 is not the only manner that complies with the specification description. For example, the stone members may be profiled and the minimal spacing does not have to be to the extent shown in Fig. 7, i.e. it could be larger or smaller.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the arrangement with at least two jointing stone members (claims 6-7) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i. Claim 6 is vague and indefinite in that it is not clear what the claim encompasses. Where is this shown in the drawings? What is the scope of the claim since such may not be ascertained without a corresponding showing in the drawings? Moreover, what is the claim referring to when claim 1 sets forth that the length of the stone is greater than the cutting edge? How is it possible or defined such that two stone members would comply with the requirements of claim 1?

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. It is noted that with regards to claims 23-28 and the “at least two cutting blades”, this limitation has been construed as non-simultaneous jointing of the at least two cutting blades, since there is no support in the specification nor the drawings for simultaneous jointing of two cutting blades.

8. Claims 16, 17, and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theien in view of Englert (DE 39 27 230).

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Theien discloses the invention substantially as claimed including, *inter alia*, at least one straight jointing stone (e.g. 40, 140) having an active jointing area that is longer than a length of the cutting edge (note Figs. 4 and 6). However, Theien lacks the step of performing at least one relative stroke. In that regard, Theien already teaches that it is known in the jointing art to perform at least one stroke in the longitudinal direction of the cutting edge. See c. 3, ll. 24-38. Moreover, Englert teaches, as per Applicant's description of this prior art in conjunction with the depiction of Figs. 1-2 of the same, an example of jointing wherein the jointing device performs at least one relative stroke between the jointing stone (13) and the inherent cutting edge (not clearly shown in the Figures) wherein the stroke length is inherently shorter than the length of the cutting edge due to the stroke length limits between the members (5, 6) and that the length of the inherent cutting edge must be as long as the length between members (5, 6) if not longer. The teachings of both Theien and Englert suggests that such a relative stroke movement allows for more even wear of the jointing stone (and therefore longer service life for the same) during the jointing operation because more of the jointing area would be used by this process. Furthermore, the stroking action provides better grinding motion between the jointing stone and the cutting edge since the grinding is not limited to one direction. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the method of Theien with the relative stroke as taught and suggested by Theien and Englert combined in order to facilitate more even wear of the jointing stone during the jointing operation.

Regarding claim 17 and similar, it appears that the modified method of Theien includes this feature. However, if it is argued otherwise, then it would have been

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obvious to the ordinary artisan at the time of the instant invention to provide the modified method of Theien with the length of the jointing stone as claimed in order to facilitate optimum use of the jointing area, since due to the length relationship between the jointing stone and the cutting edge in Theien, a longer stroke length than that claimed would be unnecessary,<sup>1</sup> and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Substantially the same reasoning applies to claim 8 in that due to the length relationship as taught by Theien, it is obvious that the stroke length would be multiple times shorter than the length of the cutting edge.

Regarding claims 19 and similar, based upon the modification above, the inherent stroke speed would be inherently multiple times smaller than the rotational speed of the rotating tool, since due to the exacting nature of jointing, a fast stroke is not advantageous for the jointing operation.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Theien in view of Englert (DE 39 27 230) as applied to claim 16 above, and further in view of Mann.

It appears that the modified method of Theien would inherently include the repetition of the stroke in the opposite direction, since it is the Examiner's opinion that this is typical of the stroking step in a jointing process. However, since the modified method of Theien is silent on this step (to the extent understood of Englert), Mann

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<sup>1</sup> The jointing area of the stone already covers more than the length of the cutting edge. Therefore, a minimal stroke length is more than sufficient to provide better grinding characteristics as well as better

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clearly teaches stroking of the jointing stone (22) with respect to the cutting edge wherein at least two strokes are performed via opposite directions which suggests that repetition of strokes will insure proper jointing characteristics. See c. 3, ll. 44-57. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified method of Theien with the at least two strokes as taught by Mann in order to facilitate the proper amount of grinding for the jointing process.

10. Claims 2, 4-7, and 28-31<sup>2</sup> are rejected under 35 U.S.C. 103(a) as being unpatentable over Theien in view of Englert (DE 39 27 230) and Mann.

Theien discloses the invention substantially as claimed including, *inter alia*, at least one straight jointing stone (e.g. 40, 140) having an active jointing area that is longer than a length of the cutting edge (note Figs. 4 and 6). However, Theien lacks the step of performing at least one relative stroke. In that regard, Theien already teaches that it is known in the jointing art to perform at least one stroke in the longitudinal direction of the cutting edge. See c. 3, ll. 24-38. Moreover, Englert teaches, as per Applicant's description of this prior art in conjunction with the depiction of Figs. 1-2 of the same, an example of jointing wherein the jointing device performs at least one relative stroke between the jointing stone (13) and the inherent cutting edge (not clearly shown in the Figures) wherein the stroke length is inherently shorter than the length of the cutting edge due to the stroke length limits between the members (5, 6) and that the length of the inherent cutting edge must be as long as the length between members (5,

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wear.

<sup>2</sup> Regarding claims 6-7, since there is no proper support for these features in the drawings and that the scope of the claims are thus unascertainable, they have been rejected herein. However, if somehow this issue is obviated, other prior art of record will be applied to these claims and the subsequent Office Action will be made FINAL. Note Osborn (US 993,398).

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6) if not longer. The teachings of both Theien and Englert suggests that such a relative stroke movement allows for more even wear of the jointing stone (and therefore longer service life for the same) during the jointing operation because more of the jointing area would be used by this process. Furthermore, the stroking action provides better grinding motion between the jointing stone and the cutting edge since the grinding is not limited to one direction. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the method of Theien with the relative stroke as taught and suggested by Theien and Englert combined in order to facilitate more even wear of the jointing stone during the jointing operation.

Regarding the at least two relative strokes, it appears that the modified method of Theien would inherently include the repetition of the stroke in the opposite direction, since it is the Examiner's opinion that this is typical of the stroking step in a jointing process. However, since the modified method of Theien is silent on this step (to the extent understood of Englert), Mann clearly teaches stroking of the jointing stone (22) with respect to the cutting edge wherein at least two strokes are performed via opposite directions which suggests that repetition of strokes will insure proper jointing characteristics. See c. 3, ll. 44-57. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified method of Theien with the at least two strokes as taught by Mann in order to facilitate the proper amount of grinding for the jointing process.

Regarding claim 2 and similar, it appears that the modified method of Theien includes this feature. However, if it is argued otherwise, then it would have been obvious to the ordinary artisan at the time of the instant invention to provide the



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modified method of Theien with the length of the jointing stone as claimed in order to facilitate optimum use of the jointing area, since due to the length relationship between the jointing stone and the cutting edge in Theien, a longer stroke length than that claimed would be unnecessary,<sup>3</sup> and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Substantially the same reasoning applies to claim 8 in that due to the length relationship as taught by Theien, it is obvious that the stroke length would be multiple times shorter than the length of the cutting edge.

Regarding claims 4 and similar, based upon the modification above, the inherent stroke speed would be inherently multiple times smaller than the rotational speed of the rotating tool, since due to the exacting nature of jointing, a fast stroke is not advantageous for the jointing operation.

### ***Response to Arguments***

11. Applicant's arguments filed 8/24/05 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

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<sup>3</sup> The jointing area of the stone already covers more than the length of the cutting edge. Therefore, a minimal stroke length is more than sufficient to provide better grinding characteristics as well as better

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hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). More specifically, while Theien and Englert employ different movement for jointing (hereinafter the term "sharpening" will be used as being synonymous with "jointing"), both methods utilize the fundamental teaching that the sharpening occurs due to the relative motion between the blade and the stone. In that regard, modifying Theien by the teachings of Englert such that reciprocating motion or stroke would also be included is not deemed to be outside the bounds of obviousness. In fact, it is the Examiner's position that this additional function or step allows for Theien's invention to be more versatile to the extent that now the sharpening operation would not be limited to having the blade rotating relative to the sharpening stone. Moreover, Theien's device is already capable of movement in the claimed reciprocating direction simply by the fact that the device is slidably adjustable relative to the axis of the blade. Note e.g. c. 9, ll. 54-66. Thus, contrary to Applicant's assertions, such a modification would not fly in the face of Theien's primary objective and/or simplicity of design. The "in situ action" that Theien is referring to is in the spindle machine, i.e. the cutting device, itself rather than the jointing/sharpening device. Furthermore, Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the

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wear.

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test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (571) 272-4508. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (571) 272-4514. In lieu of mailing, it is encouraged that all formal responses be faxed to **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at (866) 217-9197 (toll-free).

cg

November 14, 2005



**Charles Goodman**  
**Primary Examiner**  
**AU 3724**

CHARLES GOODMAN  
PRIMARY EXAMINER

NEW DRAWING SHEET

10/073,668

Inventor: Heinrich Englert

Filing Date: 2/8/2002

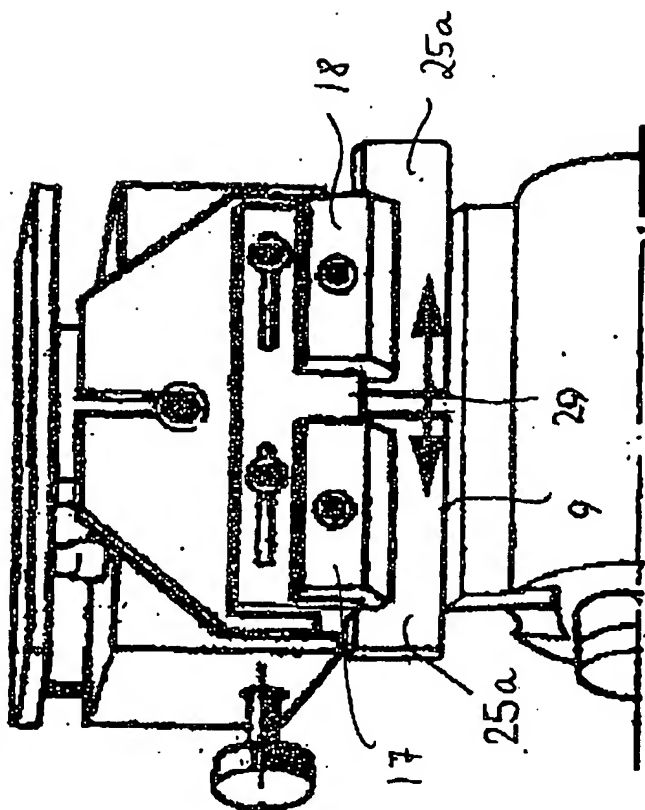


Fig. 7